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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,065	01/29/2002	Dennis Chia-Bin Chen	53394.000559	3687

21967 7590 12/01/2004

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[REDACTED] EXAMINER

STEPHENS, JACQUELINE F

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER
3761

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/058,065	CHEN ET AL.
	Examiner	Art Unit
	Jacqueline F Stephens	3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Alemany et al. USPN 4834735.

As to claims 1, 3-7, 15, 17-21, 22, 24, 26, and 28, Alemany discloses an absorbent core and by description, a method of designing an absorbent core comprising a composite and a wrapping material adjacent to the outer surface of the composite. The absorbent core is associated with an absorbent article, wherein the core further comprises a front pad **642** and a back pad **674** (Figures 6 and 7). It is the examiner's first position that pages 9, lines 12-24; page 10, lines 6-28; and page 21, line 25 through page 22, line 4 of the specification sets forth materials capable of providing the claimed absorptive capacity. Alemany teaches similar materials for the core (col. 7, line 58 through col. 9, line 28). Thus, Alemany inherently includes a core capable of providing

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the claimed absorptive capacity. "When the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980)." In the present case, the reference has met the structural requirements of the claim.

It is noted however, that Alemany does not specifically disclose the absorbent core comprises a front pad that has an absorptive capacity of at least about 32 grams of an aqueous solution containing 1.0 weight % sodium chloride absorbed after ten minutes of contact with the aqueous solution while under a restraining pressure of about 0.5 psi. However, Alemany recognizes the size and concentration of materials of the absorbent core can be varied and this will affect the absorbent capacity in specific regions (col. 7, lines 57-67; col. 12, lines 41-59; col. 20, lines 6-68). Alemany, therefore, recognizes the absorbent capacity is a result effective variable of the materials used to makeup the core. It is the examiner's second position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Alemany with the claimed absorbent capacity, since discovering an optimum value of a result effective variable involves only routine skill in the art.

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Alemany teaches the shape, size, and positioning of the acquisition zone (insult point) is important with respect to the rapid acquisition of fluids and the point should be positioned with respect to the area of typical liquid deposition of the absorbent member (col. 15, lines 20-36).

Additionally, regarding claims 1, 3-7, 15, 17-21, and 26 the claimed test results are the outcome of performing the disclosed test procedures. The process of performing the tests are part of the method of producing the claimed article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

MPEP 2113.

As to claims 2, 16, 23, 25, and 27, Alemany discloses a circular insult point (Figures 1, 4, 5, and 6). Alemany does not specifically disclose a two-inch diameter circle. Alemany teaches the shape, size, and positioning of the acquisition zone (insult point) is important with respect to the rapid acquisition of fluids and the point should be positioned with respect to the area of typical liquid deposition of the absorbent member (col. 15, lines 20-36). It would have been obvious to one having ordinary skill in the art to determine the optimal size of the insult point for achieving maximum fluid acquisition.

"In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device."

As to claims 8 and 10, see col. 20, lines 15-28.

As to claims 9 and 11-13, see col. 7, line 58 through col. 9, line 2; and col. 11, lines 21-37.

As to claim 14, see col. 18, lines 42-61.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571)272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Examiner
Art Unit 3761

November 20, 2004